REMARKS

In the Office Action mailed on March 9, 2006, the Examiner rejected claims 1-14 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claims 1, 3, 5-7, and 9-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,647,383 to *August et al.* (*"August"*)[1]; rejected claims 2, 4 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *August* in view of U.S. Patent Application Publication No. 2002/0073200 of *Babutzka et al.* (*"Babutzka"*); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *August* in view of *Babutzka,* U.S. Patent Application Publication No. 2002/133347 of *Schoneburg et al.* (*"Schoneburg"*) and U.S. Patent 6,636,0216 to *Hennessey et al.* (*"Hennessey"*); and rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *August* in view of *Babutzka, Schoneburg, Hennessey* and U.S. Patent Application Publication No. 2001/0056379 of *Fujinaga et al.* (*"Fujinaga"*).

By this Amendment, Applicants have amended claims 1, 7 and 12 to further clarify the previously claimed subject matter. Support for these changes may found in the specification at, for example, paragraphs 037, 038, 047, 088, and 089. Claims 1-14 are pending in this application.

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[1] Applicant notes that the Examiner's rejection under Section 102(b) is improper since *August* was published after the effective filing date of this Application.

Rejection Under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claims 1-14 under 35 U.S.C. § 101. Amended independent claim 1 recites, *inter alia*, "a service module configured to collect problem related data from the main system, said problem related data representing a problem identified about data in the main system" and "an inference module configured to process problem related data with knowledge representations to identify solutions and forward the solutions through the service module to the main system, wherein the identified solutions are applied to solve the problem." The "solutions" recited in amended claim 1 constitute a useful, tangible and concrete result. Applicant, therefore, respectfully requests that the Examiner reconsider and withdraw the rejection of independent claim 1 under 35 U.S.C. § 101, and claims 2-6, 13 and 14 which depend from claim 1.

Independent claims 7 and 12, although of different scope than claim 1, also recite statutory subject matter. For instance, claim 7 recites, in part, "forwarding the solutions through the service module to the main system; and applying the identified solutions to solve the problem." Further, claim 12 recites, *inter alia*, returning solutions to the main system, wherein in a first case, the service system returns solutions that solve the problem directly and, in a second case, the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module. Thus, independent claims 7 and 12 also recite a useful, tangible and concrete result. Applicant, therefore, respectfully requests that the Examiner reconsider and

withdraw the rejection of independent claims 7 and 12, along with claims 8-11 which depend from claim 7.

Rejection of Claims 1, 3, 5-7 and 9-12 Under 35 U.S.C. § 102(b)

In order for *August* to anticipate Applicant's claimed invention under Section 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." (*See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).) *August* fails to anticipate claim 1 because *August* does not to disclose, expressly or otherwise, each and every feature recited in claim 1.

As amended, claim 1 recites, *inter alia*, "a service module configured to collect problem related data from the main system, said <u>problem related data representing a problem identified about data in the main system</u>... an acquisition module configured to acquire knowledge representations, said <u>knowledge representations defining solution identification rules</u>... [and] processing problem related data with the knowledge representations by a inference module to identify solutions" (emphasis added).

August is directed toward a data search engine providing improved means for locating information stored on a plurality of network servers. (*August*, Cols. 1:7-12, 3:37-53.) However, *August* is silent with regard to the "problem related data representing a problem identified about the data in the main system," or the "knowledge

representations comprising predefined solution identification rules," as recited in amended claim 1. Since *August* fails to disclose at least these features of claim 1, the reference also does not teach "processing problem related data with the knowledge representations by a inference module to identify solutions." Accordingly, *August* fails to anticipate claim 1. Applicant, therefore, respectfully requests that the Examiner withdraw of the rejection of independent claim 1 under 35 U.S.C § 102(b), as well as claims 3, 5, and 6 at least due to their dependence from claim 1.

Amended claims 7 and 12, although of different scope than claim 1, also recite patentable subject matter like claim 1. For example, claims 7 and 12 include limitations related to "problem related data" and "knowledge representations." As discussed with regard to claim 1, *August* fails to teach these features. Accordingly, for at least the same reasons as discussed above in regard to claim 1, *August* also cannot anticipate claims 7 and 12 under 35 U.S.C. §102(b). Moreover, *August* fails to anticipate claims 9-11 at least due to the dependence of these claims from independent claim 7.

Rejection of Claims 2, 4, 8, 13 and 14 Under 35 U.S.C. § 103(a).

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. *See* M.P.E.P. § 2143. Here, the cited references

cannot support a rejection under 35 U.S.C. §103 because, among other things, *August, Babutzka, Schoneburg, Hennessey* or *Fujinaga*, taken alone or in any proper combination, do not disclose teach or suggest each and every feature recited in Applicant's claims 1 and 7.

As noted above with regard to claim 1, *August* does not disclose or suggest "a service module configured to collect problem related data from the main system, said problem related data representing a problem identified about data in the main system... an acquisition module configured to acquire knowledge representations, said knowledge representations defining solution identification rules... [and] processing problem related data with the knowledge representations by a inference module to identify solutions." Similar features are also recited in claim 7, which are neither taught nor suggested by *August*. None of *Babutzka, Schoneburg, Hennessey* or *Fujinaga* overcome these shortcomings of *August*.

The Examiner apparently cites *Babutzka* for its teaching of "remote function call connections." (Office Action, p. 9:1-6.) *Schoneburg* and *Hennessy* are cited by the Examiner together for allegedly disclosing "identifying the solutions [from a] set of predefined advices of the application, identify[ing] the solutions by applying knowledge representations in a sequential order, identify[ing] the solutions by applying knowledge representations in a hierarchical order, identify[ing] the solutions by applying knowledge representations in a dynamic adaptive order, communicat[ing] to the user by composing questions from predefined passages provided by the application, and analyses

responses that the user enters in a natural language." (Office Action, pp. 10:19-11:5.)
Fujinaga supposedly discloses "an enterprise resource planning application." (Office
Action, p. 13:1-5.) However, *Babutzka, Schoneburg, Hennessey* or *Fujinaga* do not
disclose or suggest the above-noted "problem related data" or "knowledge
representations," as recited in claims 1 and 7. Nor does the Examiner assert that
Babutzka, Schoneburg, Hennessey or *Fujinaga* disclose such features.

Accordingly, *August, Babutzka, Schoneburg, Hennessey* or *Fujinaga*, taken
alone or in any proper combination, do not teach or suggest each and every feature
recited in Applicant's independent claims 1 and 7 and, therefore, cannot support a
rejection of these claims under 35 U.S.C. § 103(a). Dependent claims 2, 4, 8, 13 and
14 are therefore allowable at least due to their corresponding dependence from claims 1
and 7.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that the
claimed invention is neither anticipated nor rendered obvious in view of the prior art
references cited against this application. Applicant, therefore, requests the Examiner's
reconsideration and reexamination of the application, and the timely allowance of claims
1-14.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 9, 2006   By:_____
                                Steven L. Ashburn
                                Reg. No. 56,636